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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/841,950 04/08/97 RIGGINS M 40827.00004

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EXAMINER

LAUFER, P

ART UNIT

PAPER NUMBER

2766
DATE MAILED:

10/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/841,950

Applicant(s)

Mark D. Riggins

Examiner 703 306 4160

Pinchus M. Laufer

Group Art Unit

2766



☒ Responsive to communication(s) filed on 20 Aug 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10 & 11

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 U.S.C. § 101

2. Claims 1-29 are rejected under 35 U.S.C. § 101 because they are non-statutory. Claims 1-29 are directed to Functional Descriptive Material, i.e., computer program *per se*. See *Examination Guidelines for Computer Related Inventions 1184 OG 87, 89 (3/26/1996) III.B.1.(a)* which states:
Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are neither physical "things" nor statutory processes.

Note that based on the disclosure, where "engine" and "keysafe" are described as software or files, the claims are directed to a collection of software routines.

In response to applicant's arguments: Applicant admits that the claims are drafted to obtain protection for a software only embodiment. A collection of software routines does not constitute statutory subject matter.

Claim Rejections - 35 U.S.C. § 112

3. Claims 2-10 and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-10 and 13: Applicant's inclusion of item of process steps into systems claim 1 by dependency creates improper hybrid claim and hence this combination of claimed subject matter is confusing. This confusion occurs, since it can not be determined if the combined claim is to be classified as only one of the statutory classes of invention, that is:

- A) a process, or
- B) a machine, or
- C) a manufacture, or
- D) a composition of matter.

Note ex parte Lyell, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) and MPEP § 2173.05(p).

Furthermore it is unclear, whether the claims mean to include all the limitations of claims 2-10, and 13.

Applicant argues the propriety of the "wherein" construction, citing Sheldon as authority.

Response: The section highlighted by applicant shows that when a dependent claim is used to qualify a previously introduced element the transitional phrase "wherein" can be employed. The example presented is: "a mechanical pencil wherein the body is formed of plastic". Note that this limitation defines further structure. However, the claims in question recite no structure, thus leaving indefinite what the claimed device comprises. An apparatus is defined by what it is, not by what it does.

Claim Rejections - 35 U.S.C. § 103

4. Claims 1-30 are rejected under 35 U.S.C. § 103 as being unpatentable over Vogler ('683) in view of Netscape version 2. (See the previous action).

Applicant argues that providing the applet "based on client privileges" is not taught by either reference. **Response:** Note that in Vogler, the Access facilitator authenticates the client before routing. Thus if the client is not privileged it does not get the CAD applet.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information Regarding Communication with the PTO

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

October 6, 1999

Pinchus M. Laufer
Pinchus M. Laufer
Primary Examiner
Art Unit 2766